



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/728,248

12/04/2003

Paul Dicarlo

01194-824001

7802

26161 7590 04/21/2010

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

TOWA, RENE T

ART UNIT

PAPER NUMBER

3736

NOTIFICATION DATE

DELIVERY MODE

04/21/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/728,248
Filing Date: December 04, 2003
Appellant(s): DICARLO ET AL.

Sean M. Dean
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 10, 2010 appealing from the Office action mailed May 21, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,368,045	Clement et al.	11-1994
US 5,197,484	Kornberg et al.	03-1993

Art Unit: 3736

US 5,467,684	Sher	11-1995
US 5,921,943	Kass	07-1999
US 5,394,887	Haaga	03-1995
US 6,331,166	Burbank et al.	12-2001
US 5,649,547	Ritchart et al.	07-1997
US 5,718,237	Haaga	02-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. **Claims 1, 4-11, 15 & 20-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Clement et al. (US 5,368,045) in view of Kornberg et al. (US 5,197,484), and further in view of Sher (US 5,467,684).

In regards to **claims 1, 15 & 22**, Clement et al. discloses a medical system system, comprising:

- (a) providing a medical system comprising:
 - (i) a housing 8 having a proximal end 10 and a distal end 16;
 - (ii) a stylet 18 having a portion in the housing, the stylet 18 being movable between a first extended position and a first retracted position; and
 - (iii) a cannula 20 coaxially receiving the stylet 18 and having a portion in the housing 8, the cannula 20 being movable between a second extended position and a second retracted position (see figs. 1-2, 3a-d & 4a-4d; column 3/lines 4-16 & 22-32);

(iv) a stylet block 36 attached to a proximal end of the stylet 18 and mounted inside the housing 8 (see fig. 2).;

wherein the stylet block 36 comprises:

a first part inside the housing 8, the first part being moveable between an extended position and a retracted position (see fig. 2).

(b) moving a stylet and a stylet block from a first position to a second position, the stylet block having an axially moveable first part and a second part attached to the stylet;

(d) causing movement of the stylet; and,

(e) moving the cannula over the stylet (see claim 19 of Clement et al.).

In regards to **claims 9 & 28**, Clement et al. discloses a medical system further comprising:

a stylet spring 44 capable of moving the stylet 18 from the first retracted position to the first extended position; and

a cannula spring 40 capable of moving the cannula 20 from the second retracted position to the second extended position (see fig. 2).

In regards to **claims 10 & 29**, Clement et al. discloses a medical system further comprising:

a first pivoting latch 52 capable of retaining the stylet 18 in a predetermined position when the stylet 18 is in the first retracted position; and

a second pivoting latch 60 capable of retaining the cannula 20 in a predetermined position when the cannula is in the second retracted position (see fig. 2).

In regards to **claims 11 & 30**, Clement et al. discloses a medical system wherein the stylet 18 comprises a notch 30 with a sharpened leading edge (see fig. 1c).

Clement et al. disclose an system, as described above, that fails to teach a stylet configured to rotate when moved from the first retracted position to the first extended position.

However, with respect to **claims 4-8, 20-21 & 23-27**, Kornberg et al. disclose a biopsy medical system including a cannula 54 having a projection 94 in contact with a track 158 associated with a housing 70;

wherein the track 158 is configured to provide unidirectional rotation to the cannula 54; wherein the track is configured to provide multidirectional rotation to the cannula 54 (see figs. 9,12,17 & 28; column 2/lines 1-9; column 3/lines 39-50 & 52-66; column 4/lines 29-31, 39-42 & 49-61; column 8/lines 18-23 & 25-32; column 9/lines 25-40 & 53-61; column 10/lines 3-6 & 19-24; column 11/lines 27-34 & 46-53; column 12/lines 2-5, 25-32 & 40-47; column 13/lines 19-25; column 14/lines 26-34 & 45-47).

Sher teaches that it is known to provide to simultaneously impart linear and rotational motion onto a piston using a projection and track mechanism such that linear motion of the piston causes rotational motion of the piston (see abstract; see figs. 1-2 & 5; see col. 1, lines 23-41; col. 2, lines 10-33).

In regards to **claims 1, 4-11, 15 & 20-30**, Both Clement et al. and Kornberg et al. teach biopsy systems. Kornberg et al. further teaches that it is known to provide a

Art Unit: 3736

biopsy system with a driving mechanism comprising a projection and track that can simultaneously rotate and linearly displace a cannula into the body of a patient to obtain a biopsy specimen therefrom, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Clement et al. with a simultaneously rotating and forwardly driven cannula mechanism as taught by Kornberg et al. in order to automatically rotate the cannula as it penetrates tissue so as to facilitate tissue penetration.

Although Kornberg simultaneously rotates and linearly displaces the cannula by means of torsion spring, Sher teaches that it is known to provide to simultaneously impart linear and rotational motion onto a piston using a projection and track mechanism such that linear motion of the piston causes rotational motion of the piston. Since Clement et al. already teach a system wherein the cannula and stylet are linearly displaced using springs (40, 44), it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Clement et al. as modified by Kornberg with a driving mechanism such that linear displacement of the cannula causes rotational motion of the cannula as suggested by Sher in order to simultaneously rotate and advance the cannula through the tissue.

Similarly, since it is also known to advance and rotate a stylet during a biopsy procedure in order to sever tissue (see figs. 5 & 7-9, and col. 3, lines 30-37, col. 6, lines 27-30, col. 7, lines 3-12 and col. 8, lines 22-29 of US 5,718,237), it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Clement et al. as modified by Kornberg and Sher above with a

Art Unit: 3736

driving mechanism such that linear displacement of the stylet causes rotational motion of the stylet as claimed in order to automatically simultaneously rotate and advance the stylet through the tissue.

2. **Claims 12, 14, 31 & 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Clement et al. ('045) in view of Kornberg et al. ('484), Sher ('684), and further in view of Kass (US 5,921,943).

Clement et al. as modified by Kornberg et al. and Sher disclose a system, as described above that teaches all the limitations of the claims except for two openings and an opening opposing the notch.

However, **Kass** discloses a system comprising a stylet including two openings for a notch, which can also be viewed as a notch and an opening opposing the notch (which can be seen in Figure 19) for receiving tissue that has been cut by cutting cannula (see Column 9, lines 15-23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Clement et al. as modified by Kornberg et al. and Sher with a notch having two openings and an opening opposing the notch, as taught by Kass, for receiving tissue that has been cut by cutting cannula.

3. **Claims 13 & 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Clement et al. ('045) in view of Kornberg et al. ('484), Sher ('684), and further in view of Haaga (US 5,394,887).

Art Unit: 3736

Clement et al. as modified by Kornberg et al. and Sher disclose a system, as described above that teaches all the limitations of the claims except for a notch comprising a ramped surface.

However, **Haaga** teaches it is known to provide a stylet with notch having a ramped surface (see Figure 3 around elements 38 and 40), to secure the stylet in the tissue against withdrawal of the of the stylet while the cutting cannula is advanced forward to complete the cutting and capturing of the specimen in the notch (see Column 2, lines 52-55).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Clement et al. as modified by Kornberg et al. and Sher with a stylet having a notch with a ramped surface, as taught by Haaga in order to secure the stylet in the tissue against withdrawal of the of the stylet while the cutting cannula is advanced forward to complete the cutting and capturing of the specimen in the notch.

4. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Clement et al. ('045) in view of Kornberg et al. ('484), Sher ('684), and further in view of Burbank et al. (US 6,331,166).

Clement et al. as modified by Kornberg et al. and Sher discloses a system, as described above, that fails to explicitly teach a step of oscillating the stylet along the axis.

However, **Burbank et al.** discloses a system further comprising oscillating the stylet 18 along the axis (see column 7/lines 21-24).

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Clement et al. as modified by Kornberg et al. and Sher with a step of oscillating the stylet along the axis as claimed in order to repetitively drive the stylet into the target tissue.

5. **Claims 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Clement et al. ('045) in view of Kornberg et al. ('484), Sher ('684), and further in view of Ritchart et al. (US 5,649,547).

Clement et al. as modified by Kornberg et al. and Sher above disclose a system, as described above, that fails to teach the step of collecting a sample in a notch of the stylet.

However, **Ritchart et al.** disclose a system comprising the step of collecting a sample in a notch 28 of a stylet; wherein the system further comprises removing the sample from the notch 28 by inserting an object 22 through an opening located in the notch 28 (see figs. 5-6). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Clement et al. as modified by Kornberg et al. and Sher with a system step comprising removing the tissue through a notch as taught by Ritchart et al. in order to conveniently collect the severed tissues (see Burbank et al., column 8/lines 39-46).

Moreover, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Clement et al. as modified by

Art Unit: 3736

Kornberg et al., Sher and Ritchart et al. above with a step of removing the sample over an inclined surface as claimed in order to remove the severed tissue.

(10) Response to Argument

6. Appellant contends that the prior art fails to teach a stylet block as claimed by the Appellant. Appellant contends that the proposed combination fails to teach a first part and a second part as claimed and that only impermissible hindsight reconstruction would provide a basis for the proposed combination. Appellants also argue that none of the prior art teaches a stylet that oscillates. These arguments have been considered but have not been deemed persuasive by the Examiner for the following reasons:

Claims 1, 15 & 22

(i) In response to the Appellant's argument that the prior art fails to teach a stylet block as claimed, the Examiner respectfully traverses. First, the Examiner observes that although the Appellant's specification mentions the words "first part" and "second part," the terms are not at all defined in the specification in greater detail, nor enumerated in the drawings. *In fact, despite the Appellant's argument that the prior art fails show a first part and a second part as claimed, the Appellants have been unable to point out, which element(s) in the specification and drawings they construe as the first part or second part.* MPEP, section 2111.01 (III), also recites:

An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) **(inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning)** (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir.

Art Unit: 3736

1992)). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and MPEP § 2173.05(a). (Emphasis added).

MPEP 2111 further stipulates:

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” >The Federal Circuit’s en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard:

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” In *re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1). 415 F.3d at 1316, 75 USPQ2d at 1329. See also< In *re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). **[Emphasis added]**

In light of the former-and-latter-mentioned MPEP sections, the Examiner notes that **claim 1** recites in part:

a stylet block attached to a proximal end of the stylet and mounted inside the housing, the stylet block comprising:

a first part inside the housing, the first part being moveable between a third extended position and a third retracted position; and

a second part attached to the proximal end of the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet.

Similarly, **claim 4** recites:

Art Unit: 3736

wherein the housing comprises a semi-cylindrical portion defining a track configured to engaged with the second part.

Moreover, **claim 5** also recites:

wherein the second part comprises a projection in contact with a track associated with the housing, the projection and track capable of cooperating to axially rotate the second part and the attached stylet when the stylet is moved between the first extended position and the first retracted position.

Thus, the claim language requires a stylet block that includes a first part and a second part, which is only defined in the claims as comprising a projection in contact with a track such that the projection and track are capable of cooperating to axially rotate itself and the attached stylet when the stylet is moved between the first extended position and the first retracted position (see claim 5). As such, the Examiner submits that the limitations “second part” as defined in the claims can broadly and reasonably be construed as *a projection* that is “attached to the proximal end of the stylet” (see claim 1) and arranged so as to be fully capable of cooperating with a track to axially rotate itself and the attached stylet when the stylet is moved between the first extended position and the first retracted position (see claim 5).

Similarly, the limitations the “first part” are defined in the claims as simply being moveable between a third extended position and a third retracted position such that the second part is rotatably engaged with the first part and able to rotate relative to an axis of the stylet (see claim 1). As such, the Examiner submits that that the limitations “first part,” as defined in the claims, can be broadly and reasonably construed as “the part or element that directly carries the stylet” such that the second part (or projection) is

Art Unit: 3736

rotatably engaged with the first part (the part or element that carries the stylet) and able to rotate relative to an axis of the stylet (see claim 1).

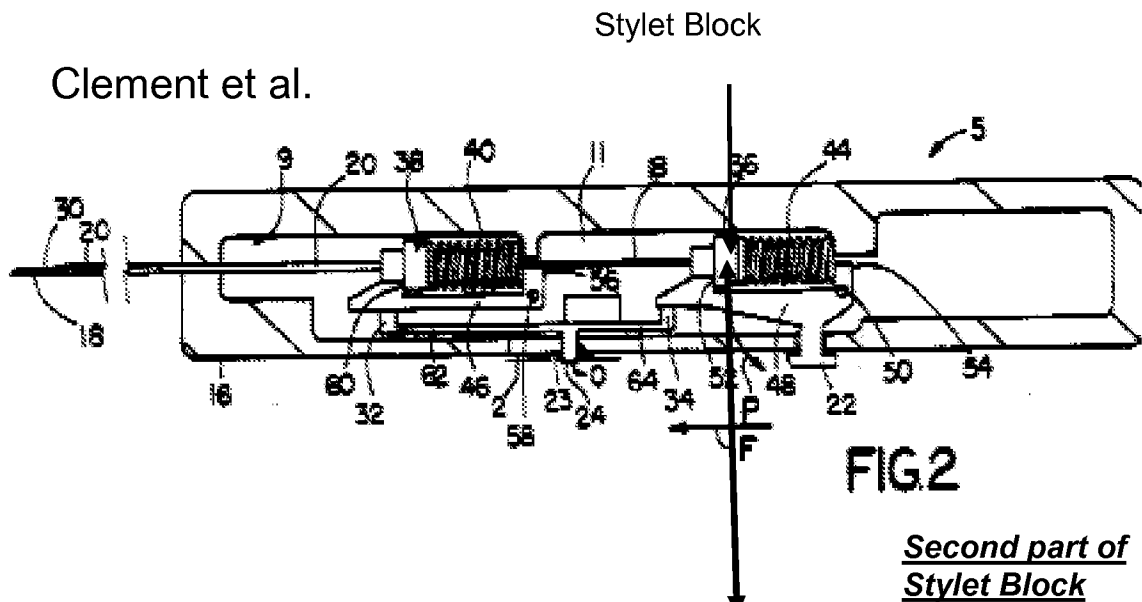
As such, the stylet block is defined as the block that includes the first and second part as defined in the claims and as explained above.

Moreover, the Appellant uses the language "first retracted position," and "first extended position" to describe the backward and forward motion of the stylet (see lines 4-5 of claim 1); "second retracted position" and "second extended position" to describe the backward and forward motion of the cannula (see lines 7-8 of claim 1); "third extended position" and "third retracted position" to describe the forward and backward motion of the first part (see lines 11-12 of claim 1). However, consistent with the Appellants' specification and claims, the first part is "attached to a proximal end of the stylet" via the stylet block (see line 9 of claim 1); as such, the "first retracted position" is in fact the same as the "third retracted position," and the "first extended position" is in fact the same as the "third extended position." As such, the movement of the first part is the same as that of the stylet, which can be moved backward to cock the device or released forward under the force of a compressed spring to pierce the skin.

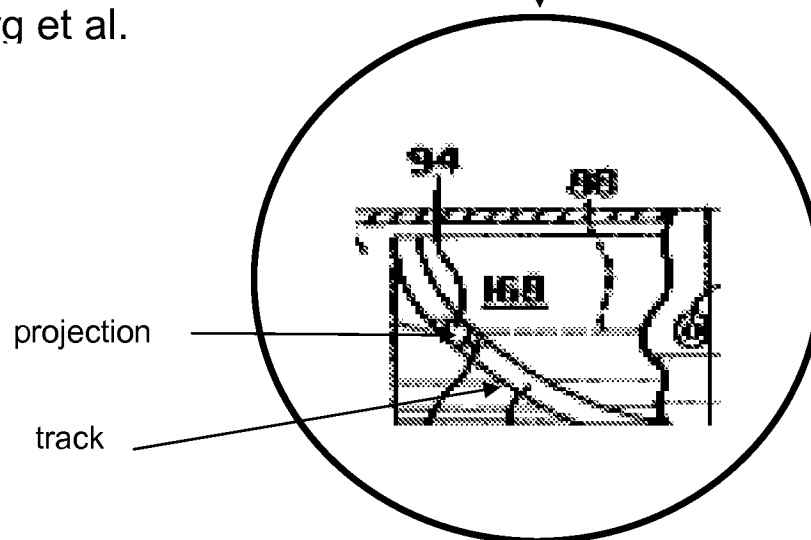
As such, with regard to the Applicant's argument that neither one of Clement et al., Kornberg and Sher teaches "a first part inside the housing, the first part being moveable between a third extended position and a third retracted position; and a second part attached to the proximal end of the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet," the Examiner respectfully traverses. The Examiner's proposed modifications are summary

Art Unit: 3736

in the illustration provided below. The Examiner notes that the claim limitations "first part" is defined in the claim as being "inside the housing" and being "moveable between a third extended position and a third retracted position." As explained in the last Office action at pages 2-3, the stylet block (i.e. collar 36) of **Clement et al.** include a first part



Kornberg et al.



Art Unit: 3736

(i.e. the part of the stylet block that carries the stylet 18), which part is fully located within a cavity 11 of the housing 16 (see col. 3, lines 22-27); wherein the stylet block 36 with the first part are moveable between an extended position and a retracted position (see figs. 3a & 4a; col. 3, lines 63-67). Similarly, **Kornberg** teaches a cannula block comprising a second part (i.e. the projection 94), the second part 94 is attached to a proximal end of the cannula 54 via larger diameter section 55 (see figs. 14-17). As such, the second part 94 is able to rotate relative to an axis of the cannula via track 158.

Moreover, it is well-known in this art to cause rotation and linear displacement of a cannula (as exemplified by Kornberg et al.) as well as rotation and linear motion of a stylet to facilitate tissue cutting (see figs. 5 & 7-9, and col. 3, lines 30-37, col. 6, lines 27-30, col. 7, lines 3-12 and col. 8, lines 22-29 of US 5,718,237 to Haaga). As such, although Kornberg et al. describe rotational and linear displacement of a cannula, one of ordinary skill in the art would have recognized the usefulness of applying the same mechanism in combination or alternatively to a stylet.

As such, consistent with the claim language, a combination of Clement et al. and Kornberg, as described in the Office action, entails adding parts such as the projection 94 (second part) and track 158 of the rotary motion mechanism of Kornberg et al. into the biopsy needle instrument of Clement et al. Such a rotary motion mechanism may involve the use of a larger diameter section 55 of Kornberg et al. to carry the stylet 18 onto the retainer block 36 of Clement et al., which would still be able to move forward (i.e. extended position) and backward (i.e. retracted position), along with the projection 94 of Kornberg that is able to rotate relative to an axis of the stylet 18 of Clement et al.

Similarly, **Sher** teaches a mechanism that causes linear motion and rotation of a piston (see figs. 1-2) for drilling or cutting (see col. 2, lines 24-26); in fact, the Appellants' motion mechanism is a mere reversal of parts of that of Sher. For example, Sher teaches a fixed projections 9 and moveable track 8 attached to a piston such the track 8 allows a piston to simultaneously rotate while it is linearly pushed forward (see figs. 1-2 & 5) whereas the Appellants' motion mechanism involves a fixed track 38 and a moveable projection 36 attached to a stylet or piston such that the projection 36 allows a stylet or piston to simultaneously rotate while it is linearly pushed forward (see figs. 2, 3A-B & 4). It is established case law that a mere reversal of parts constitutes an obvious expedient--see *In re Gazda*, 219 F. 2d 449, 452, 104 USPQ 400, 402 (CCPA 1955).

As such, contrary to the Appellants' contention, the Examiner's proposed combination teaches each and every element of the claims 1, 15 & 22 including stylet block having a first part (i.e. the portion of the device that carries or attaches the stylet) and a second part (i.e. the projection).

The Appellants contend that the Examiner has not provided any reason that a person of ordinary skill in the art who was aware of Clement and Kornberg and who desired a biopsy device with an automatically rotating cannula would modify the device described by Clement rather than just using the device described by Kornberg. First, the Examiner is not aware of any legal decision that requires an Examiner to provide reasons why a person of ordinary skill in the art who was aware of a first reference and a second reference would choose to modify the first reference rather than just using the second reference. In any event, the last Office action was not intended to modify the

Art Unit: 3736

Kornberg reference but instead the Clement et al. reference; as such there is no need for the Examiner to provide reasons why Clement is modified rather than just using Kornberg. Second, notwithstanding the erroneous requirement of the Appellants' argument, Clement et al. teach a device that includes a cannula with a cannula block and a stylet with a stylet block; the cannula and stylet can be separately cocked and sequentially (automatic) fired although sequential (automatic) firing is preferred during which actuation of the stylet causes a sequential or automatic firing of the cannula; the device is operable with one hand and can take multiple samples while the other hand is free, e.g. to manipulate an ultrasound probe (see abstract). As such, the device of Clement et al. clearly provides some advantages that are in fact ubiquitously well-known and understood in the art. For example, though the last Office action relied on Clement et al., prior art biopsy devices having both a cannula and stylet that are separately cocked and used for sequential firing abound. On the other hand, Kornberg teaches an assembly that facilitates cutting by rotating the cannula when being driven forward (see abstract). As such, one of ordinary skill in the art may be motivated to use the device of Clement et al. due to the advantages provided by the one-handed manipulation and sequential firing of the device.

(ii) In regards to the Appellants' argument that only impermissible hindsight reconstruction would provide a basis for the proposed combination, the Examiner respectfully traverses. In response thereof, the Examiner notes that MPEP 2145 (X) stipulates:

Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

Art Unit: 3736

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For example, in accordance with KSR:

a) one of ordinary skill in the art could have combined the teachings of Clement et al. with those of Kornberg et al. and Sher as suggested in the rejections supra by known methods,

b) in the combination, each element (i.e. the stylet attachment part ("first part") of Clement et al., the projection ("second part") and track of Kornberg et al. and Sher) in the combination would have performed the same function as it did separately; and,

c) one of ordinary skill in the art would have recognized that the results of the combination were predictable,

The Examiner submits that combining prior art elements according known methods to yield predictable results has recently been held to be obvious (see *KSR International Co. v. Teleflex Inc.*, 550 U.S.---, 82 USPQ2d 1385 (2007)).

Claims 5 & 24

No separate arguments were presented in support of these claims by the Appellants. However, the Appellants contend that the claims "clarify that the housing with associated track is in contact with the second part of the stylet block rather than being part of the stylet block"; nevertheless, the claims only state that the second part or projection is in contact with the track, which track is associated with the housing.

Claims 12, 14, 31 & 33


No separate arguments were presented in support of these claims by the Appellants.

Art Unit: 3736

Claims 13 & 32

No separate arguments were presented in support of these claims by the Appellants.

Claim 16

In response to the Appellants' argument that none of the prior art teaches or suggests a stylet that oscillates along the [longitudinal] axis, the Examiner respectfully traverses. For example, Sher already teaches a rotation and linear displacement mechanism that reciprocates (i.e. oscillates) (see abstract & figs. 1 & 5); for example, in figure 1, with the addition of a return spring 11, the device can be rotated and linearly displaced backward (see  arrow) after an initial forward displacement (see col. 2, lines 61-67). As such, Burbank et al. was used primarily to teach that it is known to actually oscillate a stylet. In view of the foregoing, the Examiner submits that the prior art teaches or suggests a stylet that oscillates along the [longitudinal] axis.

Claims 17-19

No separate arguments were presented in support of these claims by the Appellants.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Rene Towa/

Art Unit: 3736

Examiner, Art Unit 3736

Conferees:

Max Hindenburg

/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736

Daniel Depumpo

/Daniel G. DePumpo/

Primary Examiner, Art Unit 3700